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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,499

08/03/2006

Christopher John Burns

415852000800

7053

25225 7590 10/22/2010  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

WILLIS, DOUGLAS M

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

10/22/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,499	<b>Applicant(s)</b> BURNS ET AL.	
	<b>Examiner</b> DOUGLAS M. WILLIS	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 2 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

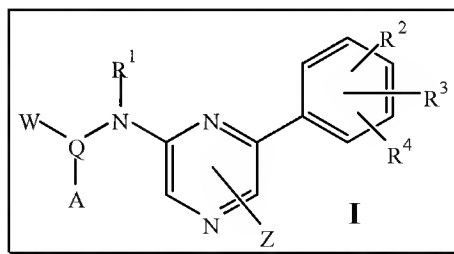
### *Status of the Claims / Priority*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the *Final Rejection*, mailed on March 22, 2010, has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission, filed on September 21, 2010, has been entered.

Claims 1-13 and 15-17 are pending in the current application. According to the *Amendments to the Claims*, filed September 21, 2010, claim 1 was amended and claim 14 was cancelled. This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/AU2003/001661, filed December 11, 2003, which claims priority under 35 U.S.C. § 119(e) to US Provisional Application No. 60/483,399, filed June 26, 2003, and under 35 U.S.C. § 119(a-d) to AU 2002953255, filed December 11, 2002.

### *Status of Restrictions / Election of Species*

Applicant's affirmation of the following election, without traverse, in the reply filed on December 29, 2009, is acknowledged: a) Group I - claims 1-10; and b) substituted pyrazine of formula I - p. 57, Table 1, example 8.



The requirement was made FINAL in the *Non-Final Rejection*, mailed on October 15,

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2009.

This application contains claims 11-13 and 15-17, drawn to nonelected inventions, without traverse, in the reply filed on September 21, 2010. A complete reply to the final rejection may include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.02.

The sections of U.S.C. Title 35 that formed the basis of prior rejections formulated, as well as any references supporting said rejections, that are not included with this Office action, may be found in either the *Non-Final Rejection*, mailed October 15, 2009, or the *Final Rejection*, mailed on March 22, 2010. Furthermore, any rejections and/or objections of record not explicitly addressed herein below, are hereby withdrawn, in light of applicant's arguments and/or the *Amendments to the Claims*, filed September 21, 2010.

Thus, a third Office action and prosecution on the merits of claims 1-10 is contained within.

#### ***Status of Claim Rejections - 35 U.S.C. § 102***

Applicant's arguments, on page 9 of the *Remarks*, filed September 21, 2010, with respect to claims 1, 3-8 and 10, have been fully considered, but are not persuasive. Consequently, the rejection of claims 1, 3-8 and 10, made in the *Final Rejection*, mailed on March 22, 2010, is hereby maintained for the reasons of record.

Applicant primarily argues that Burns, et al. in *WO 02/060492* is not properly citable with regard to the present claims as it is the work of the same inventors. Moreover, applicant further argues that Burns, et al. in *WO 02/060492* is not properly made the basis for rejection under either 35 U.S.C. § 102(a) or 35 U.S.C. § 102(e).

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. In response to applicant's argument that (1) Burns, et al. in *WO 02/060492* is not properly citable with regard to the present claims as it is the work of the same inventors, and that (2) Burns, et al. in *WO 02/060492* is not properly made the basis for rejection under either 35 U.S.C. § 102(a) or 35 U.S.C. § 102(e), the examiner respectfully disagrees, since, *another* means other than applicants or a different inventive entity. See *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966). The inventive entity is different if not all inventors are the same. The fact that the application and reference have one or more inventors in common is immaterial. {See *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992); and also MPEP § 2136.04}.

Applicant should note that as stated by the House and Senate reports on the bills enacting section 35 U.S.C. § 102(e) as part of the 1952 Patent Act, this subsection of 102 codifies the Milburn rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390 (1926). The Milburn rule authorized the use of a U.S. patent containing a disclosure of the invention as a reference against a later filed application as of the U.S. patent filing date. The existence of an earlier filed U.S. application containing the subject matter claimed in the application being examined indicates that applicant was not the first inventor. Therefore, a U.S. patent, a U.S. patent application publication or international application publication, by a different inventive entity, whether or not the application shares some inventors in common with the patent, is *prima facie* evidence that the invention was made *by another* as set forth in 35 U.S.C. § 102(e). {See *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969); and *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992)}.

As a result of the *Amendments to the Claims*, filed September 21, 2010, and to clarify the record, the original rejection, made in the *Final Rejection*, mailed on March 22, 2010, is

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amended below, in the section entitled *New Claim Rejections - 35 U.S.C. § 102*, to correctly replace *Y* with *Z*, with respect to formula I.

### *New Claim Objections*

Claims 2 and 9 are independently objected to because of the following informalities: the claims are dependent upon a rejected base claim. Appropriate correction is required.

### *New Claim Rejections - 35 U.S.C. § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

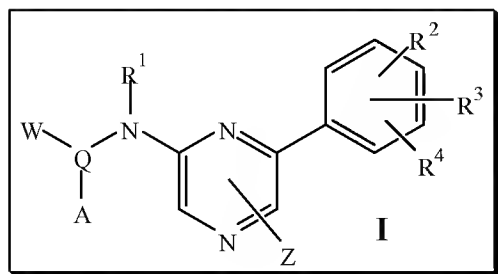
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-8 and 10 are rejected under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) as being anticipated by Burns, et al. in WO 02/060492.

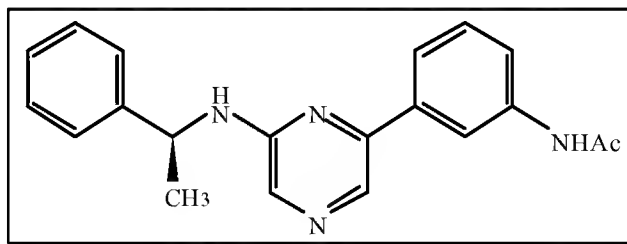
The instant application recites substituted pyrazines and pharmaceutical compositions of



the formula I, shown to the left, where  $R^1 = -H$ ;  $R^2 = -NR^8COR^9$ , wherein  $R^8 = -H$  and  $R^9 = -C_{1-4}alkyl$ ;  $R^3 = -H$ ;  $R^4 = -H$ ;  $Z = -H$ ;  $Q = -C_{1-4}alkyl$ ;  $W = -C_{1-4}alkyl$ ; and  $A = -aryl$ , as tubulin inhibitors.

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Burns, et al. (WO 02/060492), as provided in the file and cited on the IDS, teaches substituted pyrazines and pharmaceutical compositions of the formula I, shown to the right, where  $R^1 = -H$ ;  $R^2 = -NR^8COR^9$ , wherein  $R^8 = -H$  and  $R^9 = -CH_3$ ;  $R^3 = -H$ ;  $R^4 = -H$ ;  $Z = -H$ ;  $Q = -CH-$ ;  $W = -CH_3$ ; and  $A = -Ph$ , as protein kinase inhibitors [p. 38, Table 4, compound 20508; and pharmaceutical compositions - p. 17, lines 12-21].



Finally, although not explicitly discussed herein, applicant is advised to note that the Burns reference contains additional species that may anticipate the instantly recited substituted pyrazines of the formula I. Consequently, any amendments to the claims and/or arguments formulated to overcome rejections rendered under 35 U.S.C. § 102 should address this reference as a whole and should not be limited to the species discussed or disclosed explicitly herein.

### *Allowable Subject Matter*

No claims are allowed.

### *Conclusion*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37

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CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS M. WILLIS, whose telephone number is 571-270-5757. The examiner can normally be reached on Monday thru Thursday from 8:00-6:00 EST. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOUGLAS M WILLIS/  
Examiner, Art Unit 1624

/James O. Wilson/  
Supervisory Patent Examiner, AU 1624